REMARKS

Claims 2, 5, 8, 10-33, and 37 are pending in this application. Claims 17-33 have been withdrawn from consideration, leaving claims 2, 5, 8, 10-16, and 37 remaining. No claims stand allowed at this time.

This application is a Divisional Application of U.S. Patent Application No. 08/485,161, filed June 7, 1995 (hereinafter the "parent application"), now U.S. Patent No. 6,371,199.

1. Rejection of Claims 2, 5, 8, 10-16, and 37 under 35 U.S.C. §103(a)

The Office Action rejects claims 2, 5, 8, 10-16, and 37 under 35 U.S.C. §103(a) as unpatentable over Reeber in view of Chu, over Chu in view of Reeber, over the Marto and Lepere article, and over the Hesketh dissertation, for the reasons set forth in the Examiner's Answer, Paper No. 29 of Serial No. 08/485,161, which is appended to the Office Action along with the Board's Decision and the appealed claims.

Applicant respectfully traverses this rejection. MPEP §1214.04 clearly spells out the Examiner's two options (in addition to acquiescence in the Board's Decision) in the event that Examiner is reversed on Appeal to the Board:

"If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP §1002.02(c) and MPEP §1214.07. The TC Director's approval is placed on the action reopening prosecution.

The examiner may request rehearing of the Board decision. Such a request should normally be made within 2 months of the receipt of the Board decision in the TC. The TC Director's secretary should therefore date stamp all Board decisions upon receipt in the TC.

All requests by the examiner to the Board for rehearing of a decision must be approved by the TC Director and must also be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for approval before mailing."

On Appeal in the parent application, the Board reversed the Examiner's rejections, on the same arguments and art, in relation to claims raising substantially identical issues. Rather than restate the rejection in the Office Action, the Examiner has simply

appended a copy of his Answer. Justifying the present rejection in light of the Board's adverse decision, the Examiner simply states, without explanation, that the Board made a "mistake of fact" and ignored his arguments. The Examiner states the alleged "mistake of fact" by the Board was discovered upon taking up the present application for examination.

The Examiner's attempt to reject claims based on the identical arguments which were fully considered and rejected by the Board, and for which the Examiner failed to request rehearing or to reopen prosecution, is barred by the doctrines of res judicata and collateral estoppel. The Examiner may not, under the guise of recent discovery, simply ignore the adverse decision by the Board of Appeals. Putting aside the bare argument that the Board was simply wrong, it is clear that the Board considered and rejected the Examiner's argument regarding the meaning of certain facts in the record.

In the event that the Examiner elects to maintain this ground of rejection, Applicant respectfully requests an Interview with the Examiner's SPE and the Group Director to determine if MPEP §1214.04 has been appropriately applied in this case, with the explicit purpose of attempting to avoid a second, unnecessary, and wasteful hearing with the Board of Appeals on identical issues, in effectively the same application.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claims 2, 5, 8, 10-16, and 37 under 35 U.S.C. §103(a).

2. Rejection of Claims 2, 5, 8, 10-16, and 37 under the Judicially-created Doctrine of Obviousness-type Double Patenting

The Office Action rejects claims 2, 5, 8, 10-16, and 37 under the judicially-created doctrine of obviousness-type double patenting, over claims 1-9 of U.S. Patent No. 6,371,199. While acknowledging that the conflicting claims are not identical, the Examiner asserts that they are not patentably distinct because the present claims "merely recite the invention more broadly than the corresponding claims in USP '199."

Applicant respectfully traverses this rejection. 35 U.S.C. §121 provides, in relevant part, as follows:

> "A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application."

Also see MPEP §804.01.

Prosecution History. The following facts relevant to the obviousness-type double patenting rejection appear from the record of the parent application:

1. Original claims 1-33 were subject to restriction into three Groups in an Action dated August 7, 1992. Group I, relating to claims 1-9 (relating to a method of cooling a surface by nucleate boiling) was elected for prosecution, and Groups II and III, claims 10-16 and 27, and 17-26 and 28-33, respectively, were withdrawn from further consideration in the parent.

2. During prosecution in the parent application, original claims 1, 2, 5, and 8 were amended, with the limitations of claims 2, 5, and 8 incorporated into claim 1. Claims 2, 5, and 8 were canceled following these amendments. New claims 34-37 were added, with claim 37 (depending from claim 34) also being canceled.

3. Claims 1, 3-4, 6-7, 9, and 34-36 were the claims on Appeal in the parent application, and which were found by the Board to be patentable over the art of record.

4. In preparing the Preliminary Amendment in the present divisional application, claims 2, 5, and 8 were re-introduced in order to pursue subject matter relating to methods of cooling a surface by nucleate boiling, as in the parent case, but of broader scope than the patented claims. In the present application, unlike

the parent case, the Examiner did not require restriction between claims 2, 5, 8, and 37, relating to "methods of cooling a surface by nucleate boiling," and claims 10-16, relating to "methods of cooling an electronic component having at least one electronic chip means."

The Double Patenting Rejection of Claims 10-33. Claims 10-33 were subject to restriction and withdrawn in the parent application. Applicant respectfully traverses this rejection. Under 35 U.S.C. §121, a double patenting rejection is not available to the Examiner under these circumstances.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the obviousness-type double patenting rejection of claims 10-33.

The Double Patenting Rejection of Claims 1, 2, 5, and 8. The double-patenting rejection of claims 1, 2, 5, and 8, which have not been allowed, is premature at this time. A proper rejection would have been a provisional rejection. Applicant respectfully traverses this rejection for this reason. At the appropriate time during prosecution, Applicant will consider a Terminal Disclaimer for claims 1, 2, 5, and 8 over the claims patented in U.S. Patent No. 6,371,199.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the non-provisional rejection of claims 1,

2, 5, and 8 under the doctrine of obviousness-type double patenting.

CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel, patentably distinguishable over the prior art of record, and patentably distinct from the claims in U.S. Patent No. 6,371,199. The Examiner is therefore respectfully requested to reconsider and withdraw the rejections of remaining claims 2, 5, 8, 10-16, and 37, and allow all pending claims presented herein for reconsideration. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned attorney if he has any questions or comments.

Respectfully submitted,

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